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10/042,619	01/09/2002	Li Chen	1122	6985

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EXAMINER

BERNHARDT, EMILY B

ART UNIT PAPER NUMBER

1624

DATE MAILED: 11/03/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
10/042,619

Applicant(s)  
CHEN et al.

Examiner  
Emily Bernhardt

Art Unit  
1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 8/8/03
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-57 and 60-65 is/are pending in the application.
- 4a) Of the above, claim(s) 17-24, 27, 28, 47-52, 61-63, and 65 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16, 25, 26, 29-38, 41-46, 53-57, 60, and 64 is/are rejected.
- 7) ☒ Claim(s) 39 and 40 is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2 6) ☐ Other:

**Art Unit: 1624**

**Applicants' election of group I subject matter with traverse in paper no.6 is acknowledged but is not persuasive. The sole traverse is directed to the separation of I and II subject matter that is present within the same claims. Restriction is proper where there is lack of unity of invention and such is not affected by the manner of claiming- i.e. in separate claims or within a single claim. Note 37 CFR 1.141(a) which states two or more independent, distinct inventions may not be claimed in one application. One application includes the possibility of the separate inventions appearing in one claim or in more than one claim. This is also consistent with PCT Rule 13.3 for PCT cases entering the national stage. It is noted instant oxyalkyleneoxy-fused benzo derivatives covered by Group II are not particularly taught by Chong applied against Group I.**

**Thus the restriction is believed proper and is therefore made FINAL.**

**As applicants note newly presented claim 65 is directed to subject matter covered by II and thus is withdrawn.**

**This application contains claims 17-28,30,31,33,41,45,48-53,56,57 and 59-65 (in whole or in part) drawn to an invention nonelected with traverse in**

**Art Unit: 1624**

**Paper No. 6. A complete reply to the final rejection must include cancelation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.**

**Claims 1-16, 25,26,30,31,33,37,41,43,53-57 and 60 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

**1. Reason #2 of the previous action remains for all generic claims rejected herein. Applicants urge intended scope of NR7R8, NR12R13, NR15R16 is defined in the specification but do not point where such definitions appear. None is seen in the specification, only preferred embodiments for NR12R13 as R4 as pointed out previously and in the examples , the N-containing rings seen are these preferred rings for R4. Applicants' response is that all hetero atoms are intended in 5- and 6-membered rings that are both saturated and unsaturated but this was never described in the specification by way of a generic recitation and working examples (only for NR12 R13 as R4 is seen) are always saturated and contain at most one additional hetero atom, namely**

**Art Unit: 1624**

**oxygen. Where the scope cannot be readily determined as herein compliance with par.two has not been met.**

**2. Reason #6 remains. No remark regarding this rejection has been made nor an amendment to claim 1.**

**Remaining par.two rejections have been overcome by applicants' amendments or remarks. It is noted the definition of "pharmaceutically acceptable esters" in the specification is described as pertaining to carboxy-derived esters and thus is precisely defined.**

**Claims 1-16,25,26,30,31,33,37,41,43,45,53,56-57 and 60 remain rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Reason # 1 of the previous action remains notwithstanding applicants' traverse. Unlike Breuer and Smythe cited by applicants, the examiner is not basing the enablement rejection on nonexistent rings . Unlike Angstadt or Atlas Powder cited by applicants, the instant activity is part of a structure-sensitive art as binding to receptors is known to**

**Art Unit: 1624**

**be. Enablement in such cases requires more than in the predictable arts as is emphasized in MPEP 2164.03 . Fouche cited by applicants would appear to support the examiner's position since testing done was not deemed sufficient to support a scope of varying hets in a structure-sensitive art. Applicants seem to be relying on literal support in establishing enablement but describing the invention as broadly as it is claimed does not necessarily enable one to make and use the invention. If Surrey solely required literal support then the earlier Cauvallito decision would not have been heavily relied on as it was . Note the following quote taken from Cauvallito (127 USPQ 202) regarding literal support at p.205,left column: "The mere statement of an inventive concept,however, is not a sufficient basis for claiming it. Sufficient information must be given to enable those skilled in the art to practice the invention." .**

**Reason #2 under par.one is overcome by the presentation of specific tumors which are discussed in the Fischer article provided by applicants.**

**The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.**

**Art Unit: 1624**

**Claims 1-16,25,26,29-36,38,41-46,53-57,60 and 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chong for reasons of record.**

**Applicants urge Chong teaches away from instant invention since preferred embodiments include ortho-substituted phenyl derivatives and in view of the comparative showing between C(17) and C(18). With regard to the former point, a reference is not limited to just its working examples or preferred embodiments but for all that it fairly teaches. See In re Burckel 210 USPQ 67; In re Mills 176 USPQ 196; In re Lamberti 192 USPQ 278. Additionally, the case law on position isomers previously cited provides ample precedent that position isomers are prima facie structurally obvious even in the absence of a teaching to modify. It is noted that the EP searching authority also considered this reference as particularly relevant, designating it as an "X" reference. With regard to the showing between C(17) v C(18), said compounds are not even piperazine derivatives and thus are not structurally relevant to the instant rejection. However, it should be noted that the IC50 values reported in Chong are nanomolar ( $10^{-9}$ ) while applicants' data are micromolar ( $10^{-6}$ ). However, it is not true that para substitution**

Art Unit: 1624

decreases activity. Compare H(3) with J(1) which show comparable activity. There is as much spread in values for differing ortho substituents as there is for substituents at different locations. Note C(100) v. C(121). At any rate for the piperazine derivatives tested by Chong the IC50 values for the most part when converted to micromolar units are of the same order of magnitude as applicants' test data in the specification on p.140-143 for the CDK4 receptor. Applicants are reminded that while the utility relied on herein and in the art applied may be an unpredictable one, obviousness only requires a reasonable expectation of success not absolute predictability as set forth in *In re O'Farrell* 7 USPQ 2d 1673. Applicants' urging that instant compounds are selective CDK4 receptor inhibitors is not persuasive of patentability in the absence of comparative data for instant compounds with the position isomers of Chong showing superior, unexpected results. The discovery of an additional property does not make otherwise obvious compounds unobvious. Applicant must prove that their compound(s) possess a property that the prior art compound(s) do not possess- not is not disclosed to possess. See *In re Best* 195 USPQ 430; *In re Dillon* 16 USPQ 2d 1897.

**Art Unit: 1624**

**Claims 39 and 40 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.**

**Receipt of references C1 and C2 are acknowledged and thus the IDS of 3/12/02 has been completely considered. With regard to the second IDS submitted on 7/02 was there an actual 1449 provided? It appears not from the remarks made in the cover page and thus there is nothing more to consider.**

**THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).**

**A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the**

Art Unit: 1624

advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Emily Bernhardt at telephone number (703) 308-4714.

A facsimile center has been established for Group 1600. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The new fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.



**EMILY BERNHARDT**

**PRIMARY EXAMINER**

**GROUP 1600**